



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,175	11/09/2001	James R. Doran	END920010073US1	6793

7590 11/20/2009
John R. Pivnichny, Ph.D.
IBM Corporation, N50/040-4
1701 North Street
Endicott, NY 13760

EXAMINER

TRUONG, LECHI

ART UNIT	PAPER NUMBER
----------	--------------

2194

MAIL DATE	DELIVERY MODE
-----------	---------------

11/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES R. DORAN,
PAUL WILLIAM EVERETT
GORDAN G. GREENLEE,
and ASHRAF N. IBRAHIM

Application No. 10/037,175
Technology Center 2100

Mailed: November 20, 2009

Before DELORES LOWE, *Review Team Paralegal*
LOWE, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on November 16, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter requiring attention prior to docketing.

PRIOR ORDER FOR RETURN

A prior “Order Returning Undocketed Appeal to Examiner” was mailed on January 5, 2007 wherein the Examiner was instructed that corrections were required. A review of the file finds that the required corrections have not been made or have not been made in entirety. The matters still requiring attention prior to docketing are identified below.

INFORMATION DISCLOSURE STATEMENT

Appellants filed an Information Disclosure Statement (IDS) dated November 9, 2001. There is no indication on the record that the Examiner has considered the above Information Disclosure Statement. MPEP § 609 requires the Examiner to consider any Information Disclosure Statement filed by Applicant if timely submitted. A written communication notifying Appellant of the Examiner’s consideration of the above Information Disclosure Statement is required.

EXAMINER’S ANSWER, HEADINGS

A review of the file indicates that the Examiner’s Answer filed June 5, 2006 does not comply with the guidelines provided in MPEP § 1207.02 because it does not contain all of the required heading items. Specifically, the Examiner’s Answer must contain the following heading items in the following order:

- (1) *Real party in interest.*
- (2) *Related appeals and interferences.*
- (3) *Status of claims.*

- (4) *Status of amendments After Final.*
- (5) *Summary of claimed subject matter.*
- (6) *Grounds of rejection to be reviewed on appeal.*
- (7) *Claims Appendix.*
- (8) *Evidence Relied Upon.*
- (9) *Grounds of Rejection.*
- (10) *Response to Argument.*
- (11) *Related Proceedings Appendix..*

An in-depth review of the Examiner's Answer indicates that the following sections are missing from the Examiner's Answer mailed June 5, 2006 and/or are not complete or clear in setting forth agreement or disagreement with the Appeal Brief:

- 1) "Claims appendix",

A substitute Examiner's Answer that is in compliance with the guidelines is required. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 (8th ed. Rev. 6, Sept 2007) for details.

Accordingly, it is ORDERED that the application be returned to the Examiner:

- 1) to consider the Information Disclosure Statement filed November 9, 2001;
- 2) to vacate the Examiner's Answer mailed June 5, 2006, and submit a revised Examiner's Answer in accordance with the MPEP; and
- 3) for such further action as may be appropriate.

Application No. 10/037,175

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

dal

John R. Pivnichny, Ph.D.
IBM Corporation, N50/040-4
1701 North Street
Endicott NY 13760